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PARK, CHAN S				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/804,062

**Applicant(s)**

KODAMA ET AL.

**Examiner**

CHAN S. PARK

**Art Unit**

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date 20080315
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Objections*

The following quotations of 37 § CFR 1.75(a) is the basis of objection:

(a) The specification must conclude with a claim particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention or discovery.

1. Claim 4 recites the limitation of "wherein the incompatible part detection unit performs a processing for detecting again only the incompatible part when the result of the incompatibility detection processing has been stored". It is unclear as to whether the re-detection of the incompatible part is performed when (that is, right after) the result information is stored. If so, the incompatible part would apparently be detected again as the incompatible part during the re-detection step since there have been no changes/modifications to the detected incompatible part. Therefore, the examiner suggests amending the claim to recite "wherein the incompatible part detection unit performs a processing for detecting again only the incompatible part after the result of the incompatibility detection processing has been stored".

With respect to claims 11 and 18, arguments analogous to those presented for claim 4, are applicable.

### *Claim Rejections - 35 USC § 101*

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 15-21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 15-21 are drawn to functional descriptive material NOT claimed as residing on a computer readable medium. MPEP 2106.IV.B.1(a) (Functional Descriptive Material) states:

"Data structures not claimed as embodied in a computer-readable medium are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer."

"Such claimed data structures do not define any structural or functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized."

Also, refer to page 53 of the Interim Guideline.

Claims 15-21, while defining a program product, do not define a "computer-readable medium" and is thus non-statutory for that reason. A program product can range from paper on which the program is written, to a program simply contemplated and memorized by a person. The examiner suggests amending the claim to state, "A computer-readable medium encoded with a computer program..." in order to make the claim statutory.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 4, 11 and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 4 recites the limitation of "the compatible part detection unit perform[ing] the incompatibility detection processing on all of the image data otherwise". It is unclear as to what kind of condition the "otherwise" is referring to. The examiner construes the condition as "when no result of the incompatibility detection processing is stored". The examiner suggests amending the claim to recite "the compatible part detection unit performs the incompatibility detection processing on all of the image data when no result of the incompatibility detection processing is stored".

With respect to claims 11 and 18, arguments analogous to those presented for claim 4, are applicable.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-3, 8-10 and 15-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Nishide et al. U.S. Patent Application Pub. No. 2003/0007173 (hereinafter Nishide).

**With respect to claim 1**, Nishide discloses an image processing apparatus (print server 12 in paragraph 79) comprising:

an image processing unit that performs a first image processing on image data including one or more image constituent parts (performing image processing on the print job having RGB images according to paragraph 85 & fig. 5);

an incompatible part detection unit that executes an incompatibility detection processing (detecting the image in RGB format in fig. 5 & note that the RGB image is incompatible with the printer according to paragraph 61); and

an accounting unit that accounts for the executed incompatibility detection processing (displaying/accounting for the detected RGB image data in the displays of figs. 5 & 7).

**With respect to claim 2**, Nishide discloses the image processing apparatus according to claim 1,

wherein the first image processing is a print job for printing the image data (performing image processing on the print job having RGB images according to paragraph 85 & fig. 5); and

the incompatible part detection unit detects, as the incompatible part from the image constituent parts, an image constituent part on which the print job cannot be performed normally (detecting the image in RGB format in fig. 5 & note that the RGB image is incompatible with the printer according to paragraph 61).

**With respect to claim 3**, Nishide discloses the image processing apparatus according to claim 1,

wherein the incompatible part includes at least:

a first image constituent part having a color format other than a color format that can be reproduced by the print job (image having the RGB format in fig. 5 & note that the RGB image is incompatible with the printer according to paragraph 61).

**With respect to claims 8-10 and 15-17**, arguments analogous to those presented for claims 1-3, are applicable.

5. Claims 1, 5, 8, 12, 15 and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by Goodman et al. U.S. Patent No. 6,757,071 (hereinafter Goodman).

**With respect to claim 1**, Goodman discloses an image processing apparatus (computer system 10 having all parts connected via a single bus 28 in col. 3, lines 25-34) comprising:

an image processing unit that performs a first image processing on image data including one or more image constituent parts (printer driver performing dithering, color biasing, image resolution on the print data in col. 4, lines 1-8);

an incompatible part detection unit (compatibility determination module 58 in fig. 4) that executes an incompatibility detection processing (comparing the compatibility between the contents of document and the characteristics of the printer in col. 5, lines 16-29); and

an accounting unit that accounts for the executed incompatibility detection processing (printer driver accounting for the detected incompatibility for further processing in col. 4, lines 19-34).

**With respect to claim 5**, Goodman discloses the image processing apparatus according to claim 1, further comprising: a detection display unit that displays a detection of the incompatible part when the incompatible part is detected (notifying the incompatible detection to the user by displaying the suggested modifications in col. 5, lines 33-37).

**With respect to claims 8, 12, 15 and 16**, arguments analogous to those presented for claims 1 and 5, are applicable.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goodman as applied to claim 5 above, and further in view of Haneda U.S. Patent No. 4,734,735.

**With respect to claim 6**, Goodman discloses the image processing apparatus according to claim 5,

wherein the image processing unit further performs a second image processing (printer driver 34 processing/replacing yellow image with another color for printing in col. 6, lines 51-54);



the second image processing is executed on the incompatible part when an instruction is given in response to a display of the incompatible part (note that the modification is only performed to convert the yellow image to other color based on the user instruction in col. 4, lines 25-34 & col. 6, lines 51-54); and

the instruction instructs to execute the second image processing on an image constituent part set as a target of the incompatibility detection processing (printer driver 34 processing/replacing yellow image with another color for printing in col. 6, lines 51-54).

Goodman, however, does not explicitly disclose the image processing apparatus for combining the incompatible part subjected to the second image processing with an image constituent part other than the incompatible part subjected to the second image processing.

Haneda discloses an image processing apparatus for only converting a portion having to a specific color to different color while other portions having a non-specific color remains unchanged (col. 30, lines 44-56 & col. 11, lines 65-68), wherein the converted portion and the non-converted portions of the original are apparently merged/combined to reflect one complete page/document for further processing.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to modify the image processing apparatus of Goodman to process a page having a plurality of different color images wherein only certain color image is converted and then merged/combined with non-converted image to reflect one complete page/document as taught by Haneda.

The suggestion/motivation for doing so would have been to convert only the image data having the yellow color attribute to different color while maintaining other color images (col. 30, lines 44-56 of Haneda) which do not affect the quality of the transparency printing (col. 6, lines 43-54 of Goodman).

Therefore, it would have been obvious to combine Goodman with Haneda to obtain the invention as specified in claim 6.

**With respect to claim 7**, Goodman discloses the image processing apparatus, wherein the accounting unit further accounts for the executed second image processing (considering/sending the converted/replaced yellow data to the printer for printing in col. 5, lines 36-45).

7. Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goodman as applied to claim 12 above, and further in view of Haneda.

**With respect to claims 13 and 14**, arguments analogous to those presented for claims 6 and 7, are applicable.

8. Claims 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goodman as applied to claim 19 above, and further in view of Haneda.

**With respect to claims 20 and 21**, arguments analogous to those presented for claims 6 and 7, are applicable.

***Allowable Subject Matter***

9. Claims 4 and 11 would be allowable if rewritten to overcome the objection(s) under 37 § CFR 1.75(a) and the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

10. The following is a statement of reasons for the indication of allowable subject matter:

Dependent claims 4 and 11 define an image processing apparatus/method for detecting incompatibility part in the image data wherein the incompatibility detection unit/step performs a processing for detecting again only the incompatible part after the result of the incompatibility detection processing has been stored. The prior art of record do not teach or suggest the limitations of the detection storing unit that stores at least a result of the incompatibility detection processing wherein the incompatibility detection unit/step performs a processing for detecting again only the incompatible part after the result of the incompatibility detection processing has been stored, and detecting the incompatibility on all of the image data when no result of the incompatibility detection processing is stored.

***Contact Information***

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHAN S. PARK whose telephone number is (571)272-7409. The examiner can normally be reached on M-F 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (571) 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/CHAN S PARK/  
Examiner, Art Unit 2625

March 15, 2008